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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,069	08/21/2003	Wolfgang Scharf	75249-064	8800
21890	7590	10/07/2005	EXAMINER	
PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299			SELLERS, ROBERT E	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,069

Applicant(s)

SCHARF ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/21/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21, 24, 25, 33 and 34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ray-Chaudhuri et al. Patent No. 4,268,656 or Nagase et al. Patent No. 5,077,355.

1. Ray-Chaudhuri et al. discloses a powder coating (col. 8, lines 30-32) comprising a polyepoxide, a curing agent and a solid (col. 8, lines 60-65) co-curing agent derived from the reaction of a polyepoxide and a secondary amino group-containing piperazine (col. 3, line 46 to col. 4, line 11) in an epoxy:secondary amino group ratio of preferably between 1.2:1 and 3:1 (col. 3, lines 52-53 and col. 9, Table III).

2. Nagase et al. sets forth a powder coating (col. 1, lines 37-43) prepared from an epoxy resin, a curing agent of an solid (col. 4, Synthetic Example 1, line 51) adduct of an epoxy resin, a secondary amino group-containing imidazole and a polyhydric phenol in an epoxy:secondary amino group equivalent ratio of from 1.2:1 to 2.5:1 and a phenolic:secondary amino group equivalent ratio of from 0.4:1 to 2.0:1 (col. 2, lines 33-43).

3. Ray-Chaudhuri et al. and Nagase et al. do not specify the epoxy and nitrogen levels claimed as an epoxy value of from 0.25 to 2.2 equivalents/kg and a nitrogen content of from 0.2 to 4.5% by weight. Based on the equivalent ratio of epoxy:secondary amino groups of the solid adducts of the references, the prior art epoxy-functional reaction products inherently possess an epoxy value and nitrogen content within the claimed parameters. The burden of proof shifts to applicants to challenge the inherency (*In re Fitzgerald*, 205 USPQ 594, CCPA 1980 and MPEP §§ 2112-2112.02).

Claims 1-21, 24-28, 33 and 34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kooijmans et al. Patent No. 4,362,847.

4. Kooijmans et al. report an aqueous powder suspension (col. 9, lines 38 and 59-64) obtained from a non-acidic resinous compound (col. 1, lines 65-68) such as an epoxy resin (col. 2 line 44) including an epoxy resin-secondary amine adduct (col. 3, line 46 to col. 4, line 4) wherein from 33-100% of the available epoxy groups are reacted with the secondary amine (col. 4, line 57 to col. 5, line 1).

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5. Patentees do not specify the epoxy value and nitrogen content. Based on the extent of the reaction of the epoxy groups in the epoxy-functional reaction product of Kooijman et al., the adduct of the reference inherently possess an epoxy value and nitrogen content within the claimed parameters. The burden of proof shifts to applicants to challenge the inherency (*In re Fitzgerald*, 205 USPQ 594, CCPA 1980 and MPEP §§ 2112-2112.02).

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soma et al. Patent No. 4,265,803.

6. Soma et al. (col. 34, Example 12) shows the solid reaction product of an epoxy resin and bis(2,2,6,6-tetramethyl-4-piperidyl)sebacate (named in claim 22).

7. The claimed epoxy value and nitrogen content is not recited. It would have been obvious to react the piperidyl compound of Soma et al. with the epoxy resin such that unreacted epoxy groups remain and the claimed nitrogen content is satisfied in order to produce a curable epoxy resin.

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Claims 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray-Chaudhuri et al., Nagase et al. and Kooijmans et al. in view of German Patent No. 3,600,395.

8. Ray-Chaudhuri et al., Nagase et al. and Kooijmans et al. are described hereinabove. The claimed polyester is not recited. The abstracts of the German patent teach a powder coating derived from an epoxy resin and a carboxylated polyester.

9. It would have been obvious to employ the carboxylated polyester of the German patent as the curing agent of Ray-Chaudhuri et al., Nagase et al. and Kooijmans et al. in order to improve the corrosion resistance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712

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9/28/2005